

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE			
In re Application of: David J. Wendell <i>et al.</i>			
Serial No.:	10/798,669	Pat. No.:	7,743,902
Filed:	March 11, 2004	Confirm. No.:	6277
Docket No.:	247171/000426USP1	Examiner:	Michael C. McCullough
Title:	OPTICAL COIN DISCRIMINATION SENSOR AND COIN PROCESSING SYSTEM USING THE SAME	Group Art:	3653
		Customer No.	41230

### **REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT**

**MAIL STOP AMENDMENT – VIA EFS**  
 COMMISSIONER FOR PATENTS  
 U.S. Patent & Trademark Office  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

Dear Commissioner:

U.S. Patent No. 7,743,902 B2 issued on June 29, 2010 (“‘902 Patent”), listing a Patent Term Adjustment of 1284 days. Pursuant to 37 C.F.R. § 1.705(d), Applicants request reconsideration of the patent term adjustment. Applicants believe that **the correct Patent Term Adjustment is 1754 days**. This Request for Reconsideration of Patent Term Adjustment is being filed within two months of the issue date, i.e., by August 29, 2010, and is thus timely. *See* 37 C.F.R. § 1.705(d). Because the Patent Term Adjustment under 35 U.S.C. § 154(b)(1)(B) was not finally determined until the issue date, this request could not have been raised in an application for patent term adjustment under 37 C.F.R. § 1.705(b). The fee set forth in 37 C.F.R. § 1.18(e) is included herewith.

## **I. The Correct Patent Term Adjustment and Bases under 37 C.F.R. § 1.702**

Applicants are entitled to a Patent Term Adjustment of **1754** days. Under 35 U.S.C. § 154(b)(1)(A) and 37 C.F.R. § 1.702(a), Applicants are entitled to **787** days of adjustment (“A Delay”). Under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.702(b), Applicants are entitled to an additional **984** days of adjustment (“B Delay”). Under 35 U.S.C. § 154(b)(2)(C) and 37 C.F.R. § 1.704, this adjustment should be reduced by **17** days (Applicant Delay). These calculations are provided below.

The U.S. District Court for the District of Columbia has made clear that patentees are entitled to patent term adjustments under both 35 U.S.C. § 154(b)(1)(A) and 154(b)(1)(B), so long as no day is counted twice. *See Wyeth v. Dudas*, 88 USPQ2d 1538 (D.D.C. 2008). The *Wyeth* court explained that the only way that the periods of time specified by Sections 154(b)(1)(A) and (B) can overlap is if they occur on the same day. *Id.*, at 1541. The court further explained that the “‘B delay’ [35 U.S.C. § 154(b)(1)(B)] begins when the PTO has failed to issue a patent within three years, not before.” *Id.* The District Court’s decision was affirmed by the Federal Circuit. *See Wyeth v. Kappos*, 591 F.3d 1364 (Fed. Cir. 2010). On February 1, 2010, the USPTO published a notice in the Federal Register entitled, “Interim Procedure for Patentees To Request a Recalculation of the Patent Term Adjustment To Comply With the Federal Circuit Decision in *Wyeth v. Kappos* Regarding the Overlapping Delay Provision of 35 U.S.C. 154(b)(2)(A).” 75 Fed. Reg. 5043-01, 2010 WL 334297 (F.R.). Accordingly, the USPTO is to calculate patent term adjustments in a manner that complies with the Federal Circuit’s decision in *Wyeth*.

In this case, the B Delay began on March 11, 2007 (i.e., three years from the date on which the application was filed), and continued until June 29, 2010 (i.e., the issue date of the ‘902 Patent). The A Delay that Applicants are entitled to accrued in the period between May 11, 2005 (i.e., fourteen months after the date on which the application was filed) and November 27, 2006 (i.e., the mailing date of the first office action), and again between December 15, 2007 (i.e., four months after the filing of a notice of appeal), and July 24, 2008 (i.e., the mailing date of the response to the appeal – an office action). Applicants Delay began on August 27, 2004 (i.e., a response to notice to file missing parts due), and continued until September 13, 2004 (i.e., the date the response was filed). Accordingly, under controlling case law, Applicants are entitled to the sum of the “A delay” and “B delay,” with no day being counted twice, and reduced by any

amount specified in 35 U.S.C. 154(b)(2)(C). As calculated below, this adjusted total is **1754 days**.

## **II. The Relevant Dates Specified in 37 C.F.R. §§ 1.702(a)-(e) and (f)**

Under 35 U.S.C. § 154(b)(1)(A) and 37 C.F.R. § 1.702(a), Applicants are entitled to an adjustment of **787 days**.

Under 37 C.F.R. § 1.702(a)(1), Applicants are entitled to an extension of the number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed and ending on the date of mailing of an action under 35 U.S.C. § 132. The application was filed on March 11, 2004. Fourteen months from that date was May 11, 2005. A non-final Office Action was subsequently mailed on November 27, 2006. The number of days under 37 C.F.R. § 1.702(a)(1) is therefore 565 days.

Under 37 C.F.R. § 1.702(a)(2), Applicants are also entitled to an extension of the number of days, if any, in the period beginning on the day after the date that is four months after an appeal was taken under 35 U.S.C. 134 and ending on the date of mailing of a proper response. A Notice of Appeal and Pre-Appeal Brief Request for Review were concurrently filed on August 15, 2007. Four months from that date was December 15, 2007. A non-final Office Action, reopening prosecution, was subsequently mailed on July 24, 2008. The number of days under 37 C.F.R. § 1.702(a)(2) is therefore 222 days.

The total Patent Term Extension under 37 C.F.R. § 1.702(a) is **787 days**.

Under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.702(b), Applicants are entitled to an adjustment of the number of days in the period beginning on the day after the date that is three years after the date on which the application was filed. This application was filed on March 11, 2004, three years after which was March 11, 2007. The '902 Patent issued on June 29, 2010. The total number of days under Section 1.702(b) is therefore 1206 days. Some of those days, however, overlapped with the days calculated under Section 1.702(a). Specifically, the 222 days accrued pursuant to Section 1.702(a)(2) occurred after the three-year date, i.e., March 11, 2007. Those days should not be counted twice. Accordingly, Applicants are entitled to an additional **984 days** pursuant to Section 703(b) (1206 days minus the 222 days of "A delay" that occurred after the three-year date).

37 C.F.R. §§ 1.702(c)-(f) do not apply.

**III. The patent is not subject to a terminal disclaimer.**

**IV. Reduction in Patent Term Adjustment under 37 C.F.R. § 1.704**

Under 35 U.S.C. § 154(b)(2)(C) and 37 C.F.R. § 1.704(b), the patent term adjustment is reduced by the number of days in excess of three months that were taken by Applicants in responding to any notice or action. A Notice to File Missing Parts was mailed on May 27, 2004. The three-month deadline for responding to the Notice to File Missing Parts was on August 27, 2004. The Response to the Notice to File Missing Parts was subsequently filed on September 13, 2004. Applicants Delay under Section 1.704(b) results in a reduction of **17 days**.

**Conclusion**

Applicants respectfully request reconsideration of the Patent Term Adjustment and a determination that Applicants are entitled to **1754 days** of Patent Term Adjustment.

Respectfully submitted,

Date: August 27, 2010

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